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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/541,942 | 08/01/2005 | Philip Raymond Hankin | SWIN 3268 | 8700 |

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| EXAMINER |
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LEWIN, ALLANA

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| ART UNIT | PAPER NUMBER |
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3764

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 02/12/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/541,942 | HANKIN, PHILIP RAYMOND | |
| | Examiner | Art Unit | |
| | Allana Lewin | 3764 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 23-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how Applicant's claimed and disclosed invention is slidable 'substantially laterally' as recited in line 8 of claim 23. As understood by the Examiner, Applicant's invention moves forward and backward, whereas lateral movement conveys and denotes side-to-side movement. Therefore, it is unclear to the Examiner what is intended by this recitation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 23, 27-31, 33 and 36-41 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Brien (US Pat. No. 4,356,660).

5. O'Brien discloses a disc or 'skid' with a substantially flat slide surface (12) on one side and a grip surface (13, 17 or 28, 30) that is capable of engaging a user's heel; the grip surface having a pliable material of a spongy or foam texture (column 1, line 68 to column 2, lines 1-2) and therefore being deformable and allowing for compressive abutment with the user's heel for a non-slip association therebetween in use; and the heel and device being slidable in a plurality of directions upon a surface. Regarding the recitation 'for exercise by articulation of the heel about the non-slip association as a pivot point upon the grip surface', Examiner notes that this is a purely functional and intended use recitation which the O'Brien device is fully capable of performing. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claim 27, O'Brien teaches the disc/skid being integrally formed (column 1, line 57) therefore comprehending Applicant's 'unitary molding'.

As to claim 28, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, the limitation of the skid being stamped or machined has not been given patentable weight.

Regarding claims 29 and 30, O'Brien teaches the disc/skid being formed of a relatively hard material such as synthetic plastic or metal (column 1, lines 57-60) and

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therefore, absent further limitation and as best understood, the O'Brien device is rendered suitable for heat sterilization as these materials are capable of sustaining high temperatures at which heat sterilization occurs.

Regarding claims 31 and 33, O'Brien discloses the disc/skid having an insert (17 or 30) to provide the grip, with, absent further limitation and as broadly recited, the insert being 'specifically shaped for a user's requirements'.

Furthermore, O'Brien discloses the disc/skid as being generally round and the grip being provided by a non-slip elastomeric material that is pliant as O'Brien teaches the grip being a pliable material of a spongy or foam texture that is formed of a conventional synthetic plastic (column 1, line 68 to column 2, lines 1-2). This pliable material fills the annular hole (16) that is defined by the inner flange (14) that extends from the grip surface to the slide surface (note Figure 3), and therefore, as such, the disc/skid incorporates a 'cushioning material' between the grip and the slide surface. Additionally, the skid has an upturned curved rim (10) away from the slide surface that provides a dished configuration for the skid, which cooperates with the grip surface in use (note Figure 3).

6. Claims 23, 29, 31-34, 36-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Weiss (US Pat. No. 5,366,403).

Weiss discloses a disc or 'skid' with a substantially flat slide surface (4) on one side and a grip surface that is capable of engaging a user's heel on the other side with the grip surface being deformable and allowing compressive abutment with the user's

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heel for non-slip association therebetween as Weiss teaches the use of a plastic of foam plate (column 2, lines 18-22), and the heel and device being capable of sliding, and therefore slidable, in a plurality of directions upon a surface. Regarding the recitation 'for exercise by articulation of the heel about the non-slip association as a pivot point upon the grip surface', Examiner notes that this is a purely functional and intended use recitation which the Weiss device is fully capable of performing. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claim 29, Weiss teaches the ring (6) being made of foam and the plate being plastic (column 2, lines 16-22), and therefore the disc/skid as a hole is formed from a plastics material.

As to claims 31-34, Weiss teaches a removable and disposable plate that is inserted into an annular ring, therefore comprehending Applicant's recitation that the 'skid includes an insert to provide the grip' as well as the insert being disposable. Additionally, as best understood and as broadly recited, the insert is 'specifically shaped for a user's requirements'. Furthermore, Weiss teaches a plurality of plates can be used with the device, therefore comprehending Applicant's 'number of different insert shapes are secured to the skid' since plates with different concavities and depths can be utilized.

Regarding claims 36-39, Weiss teaches the disc/skid being generally round (note Figure 2) with the plate being formed of plastic or foam thereby comprehending Applicant's 'non-slip elastomeric material'. Additionally, as best seen in Figure 1, the disc/skid has an upturned curved rim away from the slide surface, with the upturned rim providing a dished configuration for the skid that cooperates with the grip surface in use.

7. Claims 23, 27, 29, 36-41 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Thorne, III (US Pat. No. 6,554,674).

Thorne discloses a disc or 'skid' with a substantially flat slide surface (110) and a grip surface (310) that is capable of engaging a user's heel on the other side, the grip surface being deformable as Thorne teaches the disc/skid having a core of polyurethane foam with a density relative to water (column 3, lines 9-12), and the heel and device being slidable in a plurality of directions upon a surface. Regarding the recitation 'for exercise by articulation of the heel about the non-slip association as a pivot point upon the grip surface', Examiner notes that this is a purely functional and intended use recitation which the Weiss device is fully capable of performing. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The device is a unitary molding and formed from a plastics material since, as discussed above, Thorne teaches the use of polyurethane foam, and therefore, the grip is also provided by a non-slip elastomeric

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material that is plastic based. Furthermore, Thorne teaches the disc/skid having an upturned curved rim (140) away upwardly from the flat slide surface with the rim providing a dished configuration for the skid. Additionally, absent further limitation, since Thorne teaches the disc/skid having a core of polyurethane foam, the device incorporates a 'cushioning material' between the grip and slide surface.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien.

10. O'Brien, discussed in detail above, fails to disclose the insert as being disposable. However, it is old and well known in the art to make grips and inserts disposable so that they can be conveniently removed for cleaning and/or replacement. Therefore, it would have been obvious to an artisan of ordinary skill to have utilized a disposable insert in the O'Brien device so that the insert can be easily removed and changed when necessary.

11. Claim 35 and 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Bloeme et al (US Pat. App. Pub. No. 2003/0013373).

O'Brien, discussed in detail above, fails to teach the skid being dimpled or cross-hatched or having a ribbed surface to provide the grip, or the slide surface including guide ribs.

Bloeme discloses an analogous device and teaches the use of gripping surfaces on both the upper and lower surfaces of the device (18a and 18b) having a segmented pattern (paragraph 22), which comprehend Applicant's 'ribbed surface' or 'guide ribs'. Bloeme teaches the gripping surfaces permit contact with the user's fingers and aid in using the device (paragraph 21). Additionally, Bloeme teaches the gripping surfaces resulting in more spin.

Based on the teachings of Bloeme, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized a ribbed surface to provide the grip in the O'Brien device in order to aid in using the device, while also providing an added level of complexity and difficulty to twirling the device about the user's fingers thereby enabling the user to become more skilled in using the device. Additionally, it would have been obvious to an artisan of ordinary skill to have utilized guide ribs on the slide surface in order to improve the spin or twirling effect.

12. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Kifferstein et al. (US Pat. No. 4,157,631).

13. O'Brien, discussed in detail above, fails to disclose the grip having a recess.

14. Kiffererstein discloses an analogous device and teaches a recess formed in one surface of the device (note Figure 8). Kifferstein teaches that the recess increases the

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lift force that is exerted on the device body without significantly increasing the drag (column 3, lines 6-18).

15. Based on the teachings of Kifferstein, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized a recess in the grip of the O'Brien device in order to increase the lift force exerted on the device thereby making the device more difficult and challenging to use, but also providing a convenient opening for the user to place their finger or other limb or body part when using the device. The grip is shaped to engage the user's heel with the recess providing an open aspect that would further engage the user's heel, and therefore receive that portion of the user's Achilles tendon.

Response to Arguments

16. Applicant's arguments with respect to claims 23-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allana Lewin whose telephone number is 571-272-5560. The examiner can normally be reached on Monday-Friday, 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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February 5th, 2007

ALLANA LEWIN
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